



REMARKS/ARGUMENTS

Claims 1, 35 have been amended; claims 37-38 have been added and claims 2-34 and 36 remain unchanged. Thus, claims 1-36 are pending.

Claims 1-14, 17 24 and 27 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPTO, EAST, European Patent Office, Annual Technical Report (WIPO) and "A Java Application Framework for Support Staff and epoline" (MADRAS).

Claims 15, 16, 25, 26 and 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EAST, WIPO, MADRAS and USPTO WEST.

Claims 1 14, 17-24 and 27-35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPTO, EAST, WIPO and MADRAS.

Claims 15, 16, 25, 26 and 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EAST, WIPO, MADRAS and USPTO WEST.

As amended, all the pending claims of the subject application comply with all requirements of 35 U.S.C. Accordingly, Applicant requests examination and allowance of all pending claims.

Formal Matters

(1) Applicants request clarification from the Examiner as to (1) what subsection of 35 U.S.C. 102 the EAST, WEST and MADRAS references qualify as prior art and (2) what is the effective date of each such reference.

For the WEST reference the Examiner has provided a press release that states WEST 2.0 was released in March 2000 and WEST 2.1 was available in February 2002. There is no indication in either of the figures WEST 1 or WEST 2, however, which version of WEST the screen shots were produced from. It is clear from fig. WEST 1 that the screen shot itself was printed sometime on or after April 13, 2004 because it includes data on U.S. Patent No. 6,721,748 which did not issue until April 13, 2004.

Similarly, screen shot EAST 3 shows the front page of U.S. Patent 6,694,315 which issued on February 17, 2004. An unmarked page was included in the Office Action (stapled to the MADRAS screen shots) that seems to be a screen shot from EAST and includes a window entitled "About EAST" in the center of the page. This screen shot indicates that the EAST program is version 2.0.1.4 and has a date of June 2, 2004.

Finally the MADRAS screen shots include a date of June 27, 2003 on the top left each page.

(2) Applicants filed an IDS that was received by the Patent Office on December 11, 2001 and have received a stamped postcard from the USPTO indicating that this IDS was properly received. Accordingly, Applicants respectfully request that the Examiner consider each of the references cited in the IDS during the prosecution of this application and that an appropriate copy of the PTO 1449 form accompanying the IDS be returned to Applicants with the Examiner's initials next to each reference so considered.

The Rejections Under 35 U.S.C. § 103(a)

Claims 1-14, 17-24 and 27-35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPTO, EAST (hereinafter "EAST"), European Patent Office, Annual Technical Report (WIPO) and "A Java Application Framework for Support Staff and epoline" (MADRAS). This rejection is respectfully traversed.

Claim 1

In the First Office Action, independent claim 1 was rejected under §103 in view of the combination of WIPO and MADRAS. Applicants successfully overcame this rejection this rejection by pointing out that neither of these references taught a graphical user interface (GUI) having either first or second display sections with the attributes required by claim 1. The Second Office Action now rejects claim 1 by stating EAST teaches both the first and second display sections recited in claim 1 except that EAST "doesn't specifically show all files pertaining to one application as in the disclosure" while relying on WIPO and MADRAS to make up for this deficiency.

Applicants have carefully reviewed this new rejection and respectfully assert that a *prima facie* case of obviousness has not been established for multiple reasons.

First, as discussed above in the "Formal Matters" section, the Examiner has not properly established that the EAST or MADRAS references are properly considered prior art. At a minimum, the Examiner must establish which subsection of 35 U.S.C. 102 the EAST and MADRAS references qualify as prior art under and the effective date of each such reference. Until such is established, no rejection of any claim based on any of these references can be made.

Second, EAST does not display a "plurality of file links selectable by said user, each of said first file links providing access to a patent document that was filed in or sent from a

patent office and that is stored on a computer-readable medium in an image file format" as recited in claim 1. The Office Action states that the "details" tab of EAST shows this aspect of the invention. Applicants note, however, that the "details" tab shown in fig. EAST 1 includes a display section that includes multiple rows each listing patent numbers and next to the patent number check boxes under columns labeled "U", "1" and "2", respectively. As used in the present patent, a "file link" is a link that when selected provides access to the underlying document. The patent numbers in EAST 1 are clearly not file links. Similarly, the check boxes are not file links, instead they seem to be selection boxes. Presumably a user can select multiple selection boxes before clicking on an icon that initiates a routine that performs additional processing to identify and then presumably return the selected material. In contrast, when a user clicks on (i.e., selects) one of the claimed first file links the associated resource (e.g., the underlying document, folder, page or package) is automatically retrieved. No additional processing is required. Claim 1 has been amended to clarify this distinction. New claim 37 has been added to specify the associated resource. Support for these new claims exists at least in paragraph [37] on page 11.

Third, the Office Action states that EAST teaches "in the HTML tab (of EAST figs. 1-4) a plurality of second file links selectable by the user, providing access to a patent file". The Examiner has not clearly indicated which of the four EAST figures include the alleged second file links or which specific set of "links" in such an unidentified figure represent the second file links. Since the Examiner seems to be stating that selecting the HTML tab provides the second display section, Applicants respectfully request that the Examiner identify which of EAST figs. 1-4 represents a screen shot generated by selecting the HTML tab and then also identify the alleged "second file links" within that screen shot. Appropriate clarification is requested.

The Office Action does not allege that the secondary references WIPO or MADRAS make up for these deficiencies in EAST and as Applicants demonstrated in response to the First Office Action, neither WIPO or MADRAS teach or suggest any of the above aspects of the invention of claim 1. Thus, for at least these reasons alone, Applicants respectfully assert that a *prima facie* case of obviousness has not been established because the Office Action does not establish that the above claim limitations are taught or suggested by the prior art.

Moreover, the Office Action also acknowledges that the EAST reference does not teach or suggest that the "patent documents and said patent files accessible from said first and

second display sections all pertain to said patent application." This is not surprising since the EAST reference is an online search tool that helps Examiners retrieve results of prior art searches - searches that are designed to identify many different patent references. In contrast, the claimed invention is a graphical user interface that allows a large volume of information pertaining to a single patent application to be displayed on the screen. The Examiner states that it would be obvious to combine the teachings of WIPO and MADRAS with EAST to arrive at the invention of claim 1 because they teach similar interfaces "both displaying images of contents of a patent file". Applicants respectfully assert that the combination of WIPO and MADRAS with EAST is not proper because the purpose of the EAST and WIPO/MADRAS systems is fundamentally different. EAST is directed to a system that displays a list of search results from prior art searching where the list includes multiple different published patents. In such a system there is no need to display multiple links to different documents associated with the same patent. Thus, trying to combine EAST with WIPO/MADRAS changes the fundamental principle of operation of EAST.

The lack of motivation to combine is even more apparent when claim 2 is examined. Claim 1 requires that the first file links provide access to image file format documents of the patent and claim 2 further requires that at least some of the patent files selected by the second file links provide access to files stored in a native application program format (e.g., a word processor format - MS Word). Clearly there is no reason to provide this sort of information in a system like EAST (nor does EAST or any of the other cited references teach this aspect of claim 2). Thus, claim 2 is believed to be in condition for allowance for at least this additional reason.

The lack of motivation to combine is again evident with respect to claim 4. Claim 4 recites that the GUI further comprises a third display section that include a plurality of third file links which provide access to correspondence related to the patent application. The Office Action states WIPO teaches such a section. Even assuming *arguendo* that such is true, the databases searched by EAST include a variety of text data sources such as pre-grant publications, U.S. patents, IBM technical disclosures, etc. These databases do not include correspondence related to a patent application, and even if they did, there is no reason that the EAST system would include file links to such correspondence in a third section distinct from the first and second sections as recited in claim 4. Thus, there is no reason to combine this alleged feature of

WIPO with EAST (which isn't actually present in either WIPO or EAST) and claim 4 is believed to be in condition for allowance for at least this additional reason.

Claim 35

Claim 35 is also rejected under §103 as being unpatentable over the combination of EAST, WIPO and MADRAS. Claim 35 recites:

35. A computer graphical user interface that provides access to information pertaining to a patent or patent application, said graphical user interface comprising:

- first, second and third display sections displayed side-by-side across a width of a display;
- the first display section comprising a first plurality of rows, each row in the first plurality of rows including an image file link selectable by a user, each of the image file links providing access to a file history document stored on a computer-readable medium in an image file format, wherein each file history document represents a document that was filed in or sent from a patent office for the patent or patent application;
- the second display section comprising a second plurality of rows, each row in the second plurality of rows including a document file link selectable by a user, each of the document file links providing access to an application document that is associated with an application program and stored on a computer-readable medium, wherein at least one of the application documents is stored in a word processor format and corresponds to a file history document stored in an image file format that is accessible through the plurality of first file links; and
- the third display section including a third plurality of rows, each row in the third plurality of rows including a correspondence file link selectable by a user, each of the correspondence file links providing access to correspondence generated from one or more of an inventor client system, an in-house client system or an outside representative client system and stored on a computer-readable medium;

wherein the file history documents, the application documents and the correspondence documents accessible from the first, second and third display sections, respectively, pertain to the patent or patent application.

The Office Action states the EAST, WIPO and MADRAS references combine to teach or suggest such a system. In rejection claim 35, the Office Action copies the rejection of claim 1 almost verbatim. Claim 35 generally includes similar limitations as those discussed above with respect to claim 1 and is thus believed to be patentable over the combination of EAST, WIPO and MADRAS for at least the same reasons as those set forth above with respect to claim 1.

In addition to first and second display sections, claim 35 also requires a third display section with the first, second and third display sections being displayed side-by-side across the width of a display. The Office Action states Madras on page 2 teaches this limitation. Applicants strongly disagree. Page 2 of the Madras reference (A Java Application Framework for Support Staff and epoline) does not include any figures yet alone a figure showing three display sections displayed side-by-side across the width of a display as recited in claim 35. Nor

does it include a discussion of any particular GUI. For this reason alone, and in addition to the reasons set forth above and below, Applicants respectfully assert the Office Action has failed to establish a *prima facie* case of obviousness of claim 35.

Claim 35 also requires the additional limitations that (i) the first display section includes links to patent application documents stored in an image format, (ii) the second display section includes links to patent application documents stored in a native application format with at least one of the links provides access to a document stored in a word processor format that corresponds to one of the image format documents in the first display section, and (iii) the third display section includes links to correspondence that pertains to the same patent or patent application for which others of the first and second plurality of links pertain to. One example of a document pairing between the first and second display sections may be a pdf file of a patent application that was filed in a patent office that is accessible by a link in the first display section and a MS Word version of the same patent application that is accessible by a link in the second display section. None of the references alone or in combination teach any of these aspects of the invention of claim 35, not has the Office Action even attempted to establish such.

Thus, for all of the above reasons, Applicants respectfully assert that claim 35 is patentable over the cited references and request that the rejection of claim 35 be withdrawn.

Claim 13

Claim 13 recites:

13. A method of providing access to information pertaining to a patent application, said method comprising:
storing said information on a computer-readable medium, wherein said information includes at least (i) correspondence generated from one or more of an inventor client system, an in-house client system and an outside representative client system; (ii) patent documents filed in or sent from a patent office; and (iii) patent files associated with said patent application, wherein at least some of said patent documents are stored in an image file format and at least some of said patent files are associated with an application program;
accessing said computer-readable medium with a computer processor and using said computer processor to generate on a display at least first, second and third separate sections wherein in said first section is displayed a list of said correspondence, in said second section is displayed a list of said patent documents and in said third section is displayed a list of said patent files.

In contrast with claim 1, claim 13 does not recite that the first or second display sections include particular file links that are selectable by a user or that all files pertain to "one patent application". Instead, claim 13 recites that a computer processor generates a first display section to display a list of correspondence, a second display section to display a list of patent

documents and a third display section to display a list of pate files. Despite these obvious differences between claim 1 and 13 the Office Action copies the rejection of claim 1 almost verbatim when rejecting claim 13. Most if not all of this rejection does not make sense in the context of claim 13.

Accordingly, Applicants assert a *prima facie* case of obviousness of claim 13 has not been established and that claim 13 is allowable over the cited references. If the Examiner disagrees, Applicants request that the next Office Action specifically point out where in the cited references each of the elements of claim 13 (not the elements of claim 1) are taught or suggested.

Claim 20

Claim 20 recites:

20. A computer-implemented method of providing access to information pertaining to a patent application, said method comprising:

storing said information on a computer-readable medium accessible to a server system, wherein said information includes at least (i) correspondence generated from one or more of an inventor client system, an in-house client system and an outside representative client system; (ii) patent documents filed in or sent from a patent office; and (iii) patent files associated with said patent application, wherein at least some of said patent documents are stored in an image file format and at least some of said patent files are associated with an application program;

generating a web page from said server system, said web page including at least first, second and third separate sections wherein said first section comprises file links to said correspondence, said second section comprises file links to said patent documents and said third section comprises file links to said patent files; and

viewing said web page from a client system.

Despite the obvious differences between claim 20 and claim 1, the Office Action copies the rejection of claim 1 almost verbatim when rejecting claim 20. In doing so the Office Action has argued that EAST teaches the first display section that provides access to patent documents. Claim 20, however, requires that the first display section comprise file links to correspondence, not patent documents. Additionally, claim 20 further requires second and third display sections and the Office Action fails to establish anything in the references that corresponds to the claimed third display section.

For at least these reasons, Applicants assert a *prima facie* case of obviousness of claim 20 has not been established and that claim 20 is allowable over the cited references. If the Examiner disagrees, Applicants request that the next Office Action specifically point out where in the cited references each of the elements of claim 20 (not the elements of claim 1) are taught or suggested.

Claim 32

Claim 32 recites, among other elements, a server system comprising a processor operatively programmed to "generate a graphical user interface that can be displayed on a display ..., said graphical user interface including at least first, second and third separate sections wherein said first section comprises a list of said correspondence, said second section comprises a list of said patent documents and said third section comprises a list of said patent files".

Similar to the rejection of claim 20, the Office Action fails to recognize that the first display section in claim 32 displays a list of correspondence, not patent documents. Also, claim 32 requires second and third display sections and the Office Action fails to establish anything in the references that corresponds to the claimed third display section.

For at least these reasons, Applicants assert a *prima facie* case of obviousness of claim 32 has not been established and that claim 32 is allowable over the cited references. If the Examiner disagrees, Applicants request that the next Office Action specifically point out where in the cited references each of the elements of claim 32 (not the elements of claim 1) are taught or suggested.

Furthermore, Applicants respectfully assert that each of the claims that depend from one of independent claims 1, 13, 20, 32 or 35 is patentable for the limitations cited therein in addition to the reasons set forth above for the claims from which they depend.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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